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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/518,369	12/17/2004	Christoph Schwan	740105-108	8185
25570	7590	04/04/2008		
ROBERTS, MIOTKOWSKI & HOBBS P. O. BOX 10064 MCLEAN, VA 22102-8064			EXAMINER	
			PAINTER, BRANON C	
			ART UNIT	PAPER NUMBER
			3633	
			NOTIFICATION DATE	DELIVERY MODE
			04/04/2008	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/518,369

Applicant(s)

SCHWAN, CHRISTOPH

Examiner

BRANON C. PAINTER

Art Unit

3633

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) 1-8 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 9-18 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 December 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/CI/CD)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____
- Paper No(s)/Mail Date 06/06/06

DETAILED ACTION

Information Disclosure Statement

1. The information disclosure statement (IDS) submitted on 06/06/06 was filed after the mailing date of the non-provisional application on 12/17/04. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Claim Objections

2. Claims 9 objected to because of the following informalities:
 - a. Claim 17 lacks a proper punctuation mark.
 - b. Claim 18, "as defined in claim 9." For the purpose of this examination, the examiner presumes this should read "as defined in claim 17."
 - c. Appropriate correction is required for all preceding objections.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
4. Claims 10, 16, and 18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
5. Claims 10 and 18 recite the limitation "constructional elements (11) are selected from the group consisting of bricks, building blocks, and façade plates," while claim

16 recites that "the front brickwork (2) is made of façade plates." However, independent claims 9 and 17 state that the constructional elements (11) are used to build front brickwork (2) and/or rear brickwork (5). It is unclear how brickwork can be constructed from building blocks or façade plates rather than bricks. As best understood by the examiner, the applicant is trying to claim front and rear walls that can be made of bricks, blocks, or plates. The examiner suggests replacing the terms "front brickwork" and "rear brickwork" with less limiting terms such as "front wall" and "rear wall" to overcome the rejection. For the purposes of this examination, the examiner presumes that the terms "front brickwork" and "rear brickwork" refer to a "front wall" and "rear wall."

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

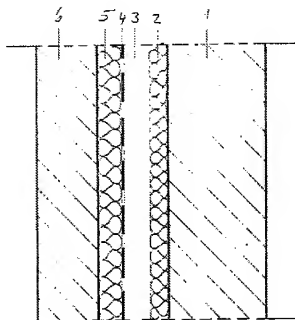
A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 9-14 and 17-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Saalfeld (English translation of DE 3,530,973 A1).
8. Regarding claim 9, Saalfeld discloses an exterior wall system having all of the applicant's claimed structure, including:
- a. Rear brickwork (1, Fig. 1) and front brickwork (6).

- b. Wherein elements of the front brickwork, only on the side facing the rear brickwork, are designed to be reflective of heat radiation (4).

Fig. 1

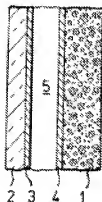


Reproduced from Saalfeld

9. Regarding claims 11-12 and 17, Saalfeld discloses a construction element (6) provided with a layer [claim 11, 17] of material [claim 12] which is reflective of heat radiation on their side facing the rear brickwork (4).
- a. The examiner notes that claim 12 is considered to be a product-by-process claim due to the phrase "vapor-deposited." The patentability of the product does not depend on its method of production. Determination of patentability is based on the product itself. See MPEP 2113. If the product in the product-by-process claim is the same as or obvious from a product of the

prior art, the claim is unpatentable even though the prior product was made by a different process." *In re Thorpe*, 227 USPQ 964, 966 (Fed. Cir. 1985).

10. Regarding claims 10 and 18, Saalfeld discloses constructional elements of bricks ("masonry" 1 & 6).
11. Regarding claim 13, Saalfeld discloses construction elements of the front brickwork coated in regions of their inner side with aluminum ("aluminum" 4).
12. Regarding claim 14, Saalfeld discloses a substantially stationary air layer between the front and rear brickworks (3).
13. Claims 9 and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by BFG Glassgroup (GB 2,054,004).
14. Regarding claims 9 and 16, Glassgroup discloses an exterior wall system having all of the applicant's claimed structure, including:
 - a. A rear brickwork (1, Fig. 1) and front brickwork (2).
 - b. Wherein the front brickwork is made of construction elements which are designed to be reflective of heat radiation (3) only on the side facing the rear brickwork [claim 1].
 - c. The front brickwork being made of façade plates (2) provided only on their inner side with reflective coating (3) [claim 16].

**FIG. 1**

Reproduced from Glassgroup

Claim Rejections - 35 USC § 103

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

16. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
 2. Ascertaining the differences between the prior art and the claims at issue.
 3. Resolving the level of ordinary skill in the pertinent art.
 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
17. Claim 15 rejected under 35 U.S.C. 103(a) as being unpatentable over Saalfeld
(English translation of DE 3,530,973 A1).

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Saalfeld discloses the claimed invention except for front brickwork with a thickness of more than 60mm. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use a front brickwork of this thickness, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *MPEP 2144.05*.

Conclusion

18. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.
19. The examiner notes that the term "masonry" is defined as "stonework or brickwork," meaning the masonry of Saalfeld may be made of brick and thus meets the limitations of claims 10 and 18 (American Heritage Dictionary).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to BRANON C. PAINTER whose telephone number is (571)270-3110. The examiner can normally be reached on Mon-Fri 7:30AM-5:00PM, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Glessner can be reached on (571) 272-6843. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/B. C. P./
Examiner, Art Unit 3633
03/19/08

/Brian E. Glessner/
Supervisory Patent Examiner, Art Unit 3633